

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Wayne C. Burton, Molly Confirmation No. 1700
Ciliberti, Lynda C. Goodrich
and Ellen Frenkel

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Docket No.: 1074-043US01/PB10059.00

Title: METHOD AND APPARATUS FOR COMPENSATING DEFIBRILLATOR OPERATORS FOLLOWING AN EVENT

CERTIFICATE UNDER 37 CFR 1.81 hereby certify that this correspondence is being transmitted via the United States Patent and Trademark Office electronic filing system on March 19, 2010.

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REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

This is a Reply Brief responsive to the final Office Action mailed April 1, 2009, which finally rejected claims 1-11 and 14-17, the Advisory Action mailed July 9, 2009, which affirmed the rejection of the claims, and the Examiner's Answer dated January 22, 2010. The due date for this Reply Brief is March 22, 2010.

No fees are believed to be due at this time. Please charge any fees that may be required or credit any overpayment to Deposit Account No. 50-1778.

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STATUS OF CLAIMS

Claims 1-11 and 14-17 are pending and are the subject of this Appeal. The originally filed application included claims 1-16. Claim 17 was added and claims 12 and 13 were canceled in an Amendment filed December 31, 2008.

Claims 1-11 and 14-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0013613 to Haller et al. ("Haller").

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Appellant submits the following ground of rejection to be reviewed on appeal:

(1) The rejection of claims 1-11 and 14-17 under 35 U.S.C. § 103(a) as being unpatentable over Haller.

ARGUMENT

In the Examiner's Answer to Appellant's Appeal Brief filed on October 29, 2009, the Examiner provided a clarification of the rejection of the claims. For brevity, this Reply Brief only addresses aspects of these new arguments. Accordingly, this Reply Brief is not intended to address all arguments provided in the Examiner's Answer, and Appellant requests full consideration of all arguments set forth in the Appeal Brief filed on October 29, 2009. In addition, Appellant respectfully requests separate review of each set of claims argued under separate headings in the Appeal Brief.

CLAIMS 1-11, 14, AND 17

Independent claim 1 is directed to a method of compensating an operator of an external defibrillator for expenses incurred as a result of use of the defibrillator for the benefit of another party to whom the operator has no duty to provide use of the defibrillator. The method of claim 1 comprises receiving a pre-determined monetary amount as a premium from the operator, maintaining a contractual relationship with the operator for a period of time in exchange for the pre-determined monetary amount, the contractual relationship including a requirement to reimburse the operator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party, determining, with a computing system, that the external defibrillator was used for the benefit of the other party during the period of time, and in response to the determination, reimbursing the operator, in accordance with the contractual relationship and with the computing system, for the at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party.

Appellant previously argued that Haller fails to disclose or suggest reimbursing *the operator* of an external defibrillator, as in claim 1. Haller discloses reimbursing *a patient*.¹ Claim 1 explicitly recites "an operator" and "another party to whom the operator has no duty to provide use of the defibrillator." A patient is different from an operator. A patient, e.g., a person requiring use of the external defibrillator, would not

¹ Haller at paragraph [0178].

use the external defibrillator on himself or herself. Thus, Haller fails to disclose or suggest reimbursing the *operator* of an external defibrillator, as in claim 1.

In addition, Appellant previously argued that Haller fails to disclose or suggest “in response to the determination, reimbursing the operator, in accordance with the contractual relationship and with the computing system, for the at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party,” as required by claim 1. That is, if it was determined that the external defibrillator was used for the benefit of the other party during the period of time in which the contractual relationship was maintained, the operator of the defibrillator is *reimbursed* for at least a portion of the expenses incurred by the operator *as a result of the defibrillator being used for the benefit of the other party*, in accordance with the contractual relationship and with the computing system.

In the Response to Arguments section provided in the Examiner’s Answer, the Examiner stated:

Claim 1 recites “reimbursing the operator, in accordance with the contractual relationship and with the computing system, for the at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party.” Haller teaches reimbursing for services rendered; furthermore teaching identification of the defibrillator to incur therapy from a remote system controlled by a provider who bills the insurance company. Therefore, the provider is reimbursed for the benefit of the other party.²

It appears that the Examiner has conflated his response to the two arguments above into a single response, and did not address either argument with any specificity.

With respect to Appellant’s argument that Haller fails to disclose or suggest reimbursing the *operator* of an external defibrillator, as in claim 1, the Examiner continues to assert³ in the Grounds of Rejection section of the Examiner’s Answer that Haller’s disclosure⁴ of a *patient* that purchases a pre-paid card from a telephone service provider is equivalent to the *operator* recited in claim 1. Again, a patient, e.g., a person

² Examiner’s Answer dated January 22, 2010 at page 8.

³ *Id.* at page 3.

⁴ Haller at paragraph [0178].

requiring use of the external defibrillator, would not use the external defibrillator on himself or herself. Hence, a patient is not an *operator*.

In the Response to Arguments section, however, the Examiner contradicts the previous assertion by contending that a *provider* that bills an insurance company is equivalent to the operator recited in claim 1. Thus, it is unclear to Appellant if the Examiner is arguing that a patient or a provider is equivalent to the operator of claim 1.

In response to the Examiner's assertion that a provider is equivalent to the operator of claim 1, Appellant notes that the Examiner ignored the plain language of claim 1 in the Response to Arguments section of the Examiner's Answer. In quoting the language of claim 1 in the Response to Arguments section, the Examiner ignored the phrase "in response to the determination" in the clause "*in response to the determination*, reimbursing the operator, in accordance with the contractual relationship and with the computing system, for the at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party" (emphasis added) of claim 1. Regardless of whether or not Haller discloses reimbursement, Haller fails to disclose reimbursing an operator *in response to a determination* that the external defibrillator was used *for the benefit of another party*, as required by claim 1. The Examiner has failed to indicate where Haller discloses such a feature.

The Examiner has also ignored the plain language of "an external defibrillator" in the preamble and "the defibrillator" in the clause "in response to the determination, reimbursing the operator, in accordance with the contractual relationship and with the computing system, for the at least a portion of the expenses incurred by the operator as a result of *the defibrillator* being used for the benefit of the other party" (emphasis added). As admitted by the Examiner,⁵ Haller fails to disclose a method directed to an *external* defibrillator. However, the Examiner asserted that the recitation of an external defibrillator is merely a recitation of intended use that must result in a *structural* difference to patentably distinguish claim 1 from Haller. Appellant disagrees for at least the reasons set forth in the Appeal Brief.

⁵ Final Office Action, mailed April 1, 2009, page 3, line 18.

Regarding Appellant's argument that the phrase "external defibrillator" must be given patentable weight, in the Response to Arguments section of the Examiner's Answer, the Examiner asserted the following:

Furthermore, the method steps involved has [sic] no relation to whether [sic] the defibrillator is an external or an internal [defibrillator]; the steps recite reimbursement methods.

Appellant disagrees.

Claim 1 recites, for example, "maintaining a contractual relationship with the operator for a period of time in exchange for the pre-determined monetary amount, the contractual relationship including a requirement to reimburse the operator for at least a portion of the expenses incurred *by the operator as a result of the defibrillator being used for the benefit of the other party*," "determining, with a computing system, that the *external defibrillator was used for the benefit of the other party* during the period of time," and "in response to the determination, reimbursing the operator, in accordance with the contractual relationship and with the computing system, for the at least a portion of the *expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party*" (emphasis added). It is unclear to Appellant how an *internal* defibrillator could be used for the *benefit of another party* to whom an operator has no duty to provide use of the defibrillator, as required by claim 1. By definition, an *internal* defibrillator is implanted in a patient. As such, using an *internal* defibrillator for the benefit of another party to whom an operator has no duty to provide use of the defibrillator seems impossible. Only an *external* defibrillator, as in claim 1, could be used for the *benefit of another party* to whom an operator has no duty to provide use of the defibrillator. Appellant's specification discloses⁶ one non-limiting example of using an *external* defibrillator for the benefit of another party to whom an operator has no duty to provide use of the defibrillator:

A problem arises when a person is perceived undergoing an event, which could be an SCA event, and where there is no duty to the patient from the operator of the defibrillator. Examples of those instances are where a patient collapses on the street, just outside an establishment that is equipped

⁶ Appellant's specification at paragraph [0010].

with an AED. In such instances, the entity that owns a defibrillator actually has an economic dis-incentive to providing aid, since the owner may have to incur potentially significant costs as a result. A kind-hearted citizen or organization of limited means might therefore hesitate to offer assistance due to the economic costs of doing so, or become unduly economically burdened after offering assistance. While the patient may be legally obligated to compensate the person providing aid, the patient is in no position to promise to do so or negotiate prices prior to receiving the aid.

Contrary to the Examiner's assertion that the method steps recited in claim 1 have no relation to whether the defibrillator is an external or an internal defibrillator, the method steps recited in claim 1 are inextricably intertwined with the defibrillator being an *external* defibrillator. As such, the phrase "external defibrillator" must be given patentable weight.

In the Response to Arguments section of the Examiner's Answer, the Examiner again contradicts arguments previously made by the Examiner by asserting the following:⁷

Haller teaches reimbursing for the use of services (i.e., use of defibrillator). Haller teaches government reimbursements for service charges incurred for using the defibrillator (i.e., a requirement to reimburse the operator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party).

These assertions by the Examiner contradict previous assertions by the Examiner because the Examiner previously admitted⁸ that Haller fails to disclose a method directed to an *external* defibrillator, as in claim 1. In no manner does Haller disclose reimbursing for the use of an external defibrillator, much less reimbursing an operator for at least a portion of the expenses incurred by the operator as a result of the external defibrillator being used for the benefit of the other party, as required by claim 1. The fact that Haller discloses⁹ that "[r]eview and authorization of government reimbursements for services

⁷ Examiner's Answer dated January 22, 2010 at page 9.

⁸ Final Office Action, mailed April 1, 2009, page 3, line 18.

⁹ Haller at paragraph [0188].

charges incurred as a result of using the various systems and methods of the present invention could also be automated," does not amount to a disclosure of "a requirement to reimburse the operator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party," as asserted by the Examiner.

Appellant previously argued that the Examiner's characterization that a contractual relationship including a requirement to reimburse is non-functional descriptive material is error. In the Response to Arguments section of the Examiner's Answer, the Examiner stated:¹⁰

a contract is a non-functional descriptive material, therefore, if there's a contractual relationship having a clause to reimburse, then that contractual relationship is the same as a contract having a clause and seen as a non-functional descriptive material.

Appellant disagrees with this conclusory statement. The Examiner has ignored that a relationship is not akin to music or mere data, and is thus not descriptive material. Without providing any reasoning whatsoever, the Examiner has simply concluded that a contractual relationship including a requirement to reimburse an operator is non-functional descriptive material because a contract including a requirement to reimburse an operator is non-functional descriptive material.

As asserted previously, the limitation that the contractual relationship includes a requirement to reimburse an operator of an external defibrillator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of another party clearly limits and therefore changes the recited relationship, and thus the maintaining step and the claim as a whole. The scope of claim 1 does not cover any method in which a contractual relationship is maintained, but rather those methods in which a contractual relationship that includes a requirement to reimburse an operator of an external defibrillator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of another is maintained. At least because this limitation of claim 1 is not non-functional descriptive material, and is

¹⁰ Examiner's Answer at page 9.

admittedly not disclosed or suggested by Haller, the rejection of claim 1 was improper and should be reversed.

In the Response to Arguments section of the Examiner's Answer, the Examiner stated:¹¹

Haller further teaches providing a contractual relationship in the sense that the patient with the defibrillator has a contract with the insurance provider for a pre-determined monetary amount (i.e. premium) to use the services for however long the patient uses the defibrillator and then providing reimbursement options for costs incurred (Haller: para. 21; para. 177).

Regardless of whether Haller describes a contractual relationship, an assertion made by the Examiner to which Appellant does not agree, Haller fails to disclose or suggest a method that includes maintaining a contractual relationship with the operator for a period of time in exchange for the pre-determined monetary amount, the contractual relationship including a requirement to reimburse the operator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party, as in claim 1. As seen in the above-quoted portion of the Response to Arguments section of the Examiner's Answer, the Examiner has simply ignored the plain language of claim 1. The contractual relationship of claim 1 includes a requirement to reimburse the operator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party. The Examiner has again incorrectly equated a *patient* with the operator of claim 1. In claim 1, an operator of an external defibrillator that incurs expenses as a result of the external defibrillator being used *for the benefit of the other party* is reimbursed. In Haller, a patient incurs expenses as a result of receiving therapy or treatment for himself or herself. In contrast to claim 1, the patient in Haller does not incur expenses as a result of an external defibrillator being used *for the benefit of the other party*.

For at least the above reasons, the rejection of independent claim 1 under 35 U.S.C. § 103(a) over Haller was improper and should be reversed. Claims 2-11, 14, and 17 depend from claim 1. At least by virtue of their dependency, the rejection of claim 2-

¹¹ Examiner's Answer at page 9.

1, 14, and 17 was also improper. Appellant respectfully requests reversal of the rejection of claims 1-11, 14, and 17 under 35 U.S.C. § 103(a) over Haller.

For at least the reasons discussed above with respect to independent claim 1, the rejection of claims 15 and 16 under 35 U.S.C. § 103(a) were improper and should be reversed.

SUMMARY

The Examiner has failed to meet the burden of establishing a *prima facie* case of nonpatentability with respect to claims 1-11 and 14-17. In view of Appellant's arguments, the final rejection of claims 1-11 and 14-17 was improper and should be reversed, and all of the pending claims should be allowed.

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